



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/781,886

02/12/2001

SadAo Ito

1232-4685

9637

27123

7590

02/28/2006

MORGAN & FINNEGAN, L.L.P.

3 WORLD FINANCIAL CENTER

NEW YORK, NY 10281-2101

EXAMINER

ROSEN, NICHOLAS D

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,886

Applicant(s)

ITO ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,14,15,18-27,34,35,38-43,46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,14,15,18-27,34,35,38-43,46 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-7, 14, 15, 18-27, 34, 35, 38-43, 46, and 47 have been examined.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3625

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7

Claims 1, 2, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Peterson et al. (U.S. Patent 6,324,522). As per claim 1, Saastamoinen discloses an information providing system, comprising: a database storing respective object prices at apparently a plurality of bases ("points of delivery") of a certain object in a case where the certain object is purchased at the plurality of bases from each supplier corresponding to the plurality of bases (paragraph beginning "The material management system," page 6 of the enclosed printout of Saastamoinen). Saastamoinen does not expressly disclose display control means for displaying information of said prices, bases, and each supplier as stored in said database on display means, but a database as Saastamoinen describes would have little purpose without display means for displaying the stored data, and Peterson teaches display control means for displaying price information, etc. (column

13, line 42, through column 14, line 16; column 15, lines 16-57; column 22, lines 15-47). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the information providing system comprise display control means, etc., for the obvious advantage of enabling concerned persons to access the data.

As per claim 2, Saastamoinen discloses unit price information about objects (paragraph beginning "The material management system," page 6 of the enclosed printout of Saastamoinen).

As per claim 7, Saastamoinen does not expressly disclose displaying cost cutting information, although information which can be used to cut costs by not paying erroneous invoices can be described as cost cutting information (see three paragraph beginning from "The material management system"), but Peterson teaches that the display control can further display cost cutting information (column 15, line 58, through column 16, line 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display cost cutting information, for the obvious advantage of increasing profitability by cutting costs.

Claims 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen and Peterson as applied to claim 2 above, and further in view of Kojima et al. (U.S. Patent Application Publication 2003/0078862). As per claim 3, Saastamoinen discloses unit price information about the objects, as set forth above, but does not expressly disclose a total quantity and/or a total amount of money; however, Kojima teaches this (Figure 46; paragraph 170). Hence, it would have been obvious to

one of ordinary skill in the art of electronic commerce to have the display control means display a total quantity and/or a total amount of money, for such obvious advantages as enabling users of the system to track total prices paid, judge the correctness of invoices, etc.

As per claim 4, Saastamoinen does not expressly disclose that said display control means displays an amount of money based on a present currency of the bases (although the prices disclosed by Saastamoinen would presumably be in a present currency of the bases), but Kojima teaches displaying an amount of money based on a present currency of a seller (Figures 17 and 46; paragraphs 100 and 170). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce to display an amount of money based on a present currency of the bases, for the obvious advantage of informing potential purchasers of how much desired or purchased objects cost.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen, Peterson, and Kojima as applied to claim 4 above, and further in view of the McKendrick article, "ResQ!Net.com Gives 5250 a Complete Makeover."

Saastamoinen does not disclose that said display control means further displays an exchange rate, but McKendrick teaches displaying an exchange rate (paragraph beginning "Version 3.2 of the product"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display an exchange rate, for the obvious advantage of enabling a user to determine the cost of an object in a preferred currency.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen and Peterson as applied to claim 2 above, and further in view of official notice. Saastamoinen does not expressly disclose displaying a difference in unit prices among objects, in addition to the unit prices themselves, but official notice is taken that it is well known to display differences between numbers (spreadsheet programs, as well as the mathematical operation of subtraction, being common and well known). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display a difference in unit prices among objects, for the obvious advantage of helping judge where savings might be made.

It is noted that claims 1-7 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claims 14, 15, and 18-20

Claims 14, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Leal et al. (U.S. Patent 5,311,437). As per claim 14, Saastamoinen discloses an information providing system, comprising: a database storing item information including respective

amount-of-money and/or respective unit price information at apparently a plurality of bases ("points of delivery") of a certain object in a case where the certain object is purchased at the plurality of bases from each supplier corresponding to the plurality of bases (paragraph beginning "The material management system," page 6 of the enclosed printout of Saastamoinen). Saastamoinen does not expressly disclose display control means for displaying information including respective amount-of-money and/or respective unit price information, bases, and suppliers, but a database as Saastamoinen describes would have little purpose without display means for displaying the stored data, and Leal teaches means for displaying information, specifically material information (column 4, line 65, through column 5, line 8; column 6, lines 17-54). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the information providing system comprise display control means, etc., for the obvious advantage of enabling concerned persons to access the information; and to have the information be material information, for the obvious advantage of applying the system disclosed by Saastamoinen to the purchase of materials.

As per claim 18, Leal teaches that the database stores weight information about materials (column 4, line 65, through column 5, line 6). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database store weight information, for the obvious advantages of comparing invoices with materials ordered or received, and designing product in accordance with a weight of materials needed or available.

As per claim 20, Leal teaches that the database stores at least one of specification information, approved color information, and environment information about materials (column 5, lines 23-65; column 6, lines 23-47). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the database to store at least one of these types of information, for the stated advantage of taking environmental information, such as requirements for hazardous waste disposal (see column 2 of Leal) into account.

Claims 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen ("Case Study on Exceptions") and Leal et al. (U.S. Patent 5,311,437) as applied to claim 14 above, and further in view of Sebastian (U.S. Patent 5,552,995). As per claim 15, neither Saastamoinen nor Leal expressly discloses that said database stores resin material information and/or mechanical parts material information, but Sebastian teaches a database storing resin material information (column 16, lines 30-36). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database store resin material information and/or a mechanical parts material, for at least the obvious advantage of providing relevant information about resins, an important class of materials.

As per claim 19, Saastamoinen discloses a database storing product information, and Leal teaches a database storing material information, but neither discloses that said control means displays information about the products in which the materials specified by said specifying are used after searching said database for the information. However,

Art Unit: 3625

Sebastian discloses a database storing material information and product information (e.g., column 4, lines 36-57; column 19, lines 57-67); and discloses displaying information about products in which the specified materials are used after searching said database for the information (column 5, line 48, through column 6, line 34; column 15, lines 9-31; column 16, lines 13-36; column 22, line 18, through column 23, line 30; claims 32 and 33). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the control means display information about the products in which the materials specified by said specifying are used after searching said database for the information, for the stated advantage of assisting in product design.

It is noted that claims 14, 15, and 18-20 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claims 21-27

Claims 21, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Peterson et

al. (U.S. Patent 6,324,522). Claims 21, 22, and 27 are closely parallel to claims 1, 2 and 7, respectively, and rejected on essentially the same grounds.

Claims 23, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen and Peterson et al. as applied to claim 22 above, and further in view of Kojima et al. (U.S. Patent Application Publication 2003/0078862); and in the case of claim 25, also in view of McKendrick's article.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen and Peterson et al. as applied to claim 22, and further in view of official notice.

Claims 23-26 are closely parallel to claims 2-6, respectively, and rejected on essentially the same grounds.

Claims 34, 35, and 38-40

Claims 34, 38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Saastamoinen ("Case Study on Exceptions") in view of Leal et al. (U.S. Patent 5,311,437). Claims 34, 38, and 40 are closely parallel to claims 14, 18, and 20, respectively, and rejected on essentially the same grounds.

Claims 35 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Leal et al. (U.S. Patent 5,311,437) as applied to claim 34, and further in view of Sebastian (U.S. Patent 5,552,995). Claims 35 and 39 are closely parallel to claims 15 and 19, respectively, and rejected on essentially the same grounds.

Claims 41-43

Claim 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Peterson et al. (U.S. Patent 6,324,522) as applied to claim 1 above and further in view of official notice. Claim 43 is rejected as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Peterson et al. (U.S. Patent 6,324,522) and official notice, and further in view of Kojima et al. (U.S. Patent Application Publication 2003/0078862) as applied to claims 2 and 3 above. Claims 41, 42, and 43 are essentially parallel to claims 1, 2, and 3, respectively; Saastamoinen does not disclose a computer-readable medium storing instructions for carrying out the recited steps, but official notice is taken that computer-readable media storing instructions are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to store instructions for carrying out the steps of claims 41, 42, and 43 on a computer-readable medium, for the obvious advantage of enabling a computer to carry out the method.

Claims 46 and 47

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Leal et al. (U.S. Patent 5,311,437) as applied to claim 14 above and further in view of official notice. Claim 47 is rejected as being unpatentable over Saastamoinen ("Case Study on Exceptions") in view of Leal et al. (U.S. Patent 5,311,437), and official notice, and further in view of Sebastian (U.S. Patent 5,552,995). Claims 46 and 47 are essentially parallel to claims

14 and 19, respectively; Leal does not disclose a computer-readable medium storing instructions for carrying out the recited steps, but official notice is taken that computer-readable media storing instructions are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to store instructions for carrying out the steps of claims 46 and 47 on a computer-readable medium, for the obvious advantage of enabling a computer to carry out the method.

Response to Arguments

Applicant's arguments filed February 7, 2006 have been fully considered but they are not persuasive. Applicant argues that "prices" in the present invention means "respective object prices at a plurality of bases of a certain object in a case where the certain object is purchased at the plurality of bases from each supplier corresponding to the plurality of bases." First, Examiner observes that this definition of prices is not an actual claim limitation.

Applicant argues that "it could have happened that the prices are different by purchasing the object from a plurality of bases or suppliers." Examiner replies that this could have happened in Saastamoinen, as well. Claims can only be found allowable based on their actual limitations, not on what could have happened, or on meanings of words that are not limitations. Applicant argues that the "points of delivery" of Saastamoinen do not correspond to "bases" as recited in the claims, where objects are purchased at bases. Examiner replies that Applicant does not in fact establish that the

“points of delivery” in Saastamoinen are not places where objects or items are purchased.

Furthermore, even if, *ad arguendo*, the object price data stored in the database of claim 1, and then displayed on the display means, can be distinguished from price data known in the prior art, that would not be sufficient to make the claims patentable. The price data would be merely non-functional descriptive material, and would not make claim 1 patentably distinct from prior art databases and display means, unless something were recited as being done with the price data that could not be done with any data.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dworkin (U.S. Patent 4,992,940) discloses a system and method for automated selection of equipment for purchase through input of user desired specifications. It is noted that Dworkin discloses a database of prices of products available from multiple suppliers (e.g., column 2, lines 25-32).

This is a Request for Continued Examination of applicant's earlier Application No. 09/781,886. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the

next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3625

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

**NICHOLAS D. ROSEN
PRIMARY EXAMINER**

February 21, 2006